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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/737,277

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L. Michael Maritzen

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06/02/2006

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EXAMINER

POINVIL, FRANTZY

ART UNIT

PAPER NUMBER

3628

DATE MAILED: 06/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/737,277	Applicant(s) MARITZEN ET AL.	
	Examiner Frantzy Poinvil	Art Unit 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>11/18/05 & 8/17/05</u> . | 6) <input checked="" type="checkbox"/> Other: <u>IDS dated 2/4/05</u> . |

DETAILED ACTION

1. Regarding the status of the claims in the instant application

In view of the Appeal Brief filed on 3/15/2006, PROSECUTION IS HEREBY REOPENED.

The Examiner has found new prior art. The Examiner is obliged to apply the newly found prior art. Thus, the finality of the prior Office action has been withdrawn and a new rejection follows. The Examiner regrets the delayed process of the application. Accordingly, claims 1-27 remain pending in the application.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-9, 11-14 and 16-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Katis (US Patent No. 6,601,761).

As per claim 1, Katis discloses a system and method for co-branding an electronic payment platform such as an electronic wallet. The system and method comprising:

a data terminal 4 having a device identifier configured as a financially-enabled e-commerce device for receiving data (figure 3, element 4); and a transaction and information clearing house (TIPCH) (figure 3, elements 6, 12, and the electronic cash token clearing house) maintaining information for a plurality of user accounts, and configured to gather electronic information from a financial institution or vendor for a user having an account within said plurality of user accounts, said TIPCH connected selectively to said data terminal (figure 3 and column 5, line 55 to column 6, line 20); wherein the TIPCH or the clearinghouses of Katis is configured for automatically transferring electronic information to said data terminal while the data terminal is connected to the TIPCH and in response to receipt of the device identifier, wherein said data terminal is populated by the TIPCH with sufficient account information about the user account, or accounts, associated with the device identifier to impart transaction functionality to the data terminal on behalf of the user (see column 7, lines 5-19 and column 8, lines 42-65).

As per claim 2, Katis discloses the data terminal is further configured for establishing a secure connection to send electronic signals to said TIPCH (see figure 3 of Katis).

As per claim 3, Katis discloses the system further comprising a financial transaction processing mechanism associated with said TIPCH, said processing mechanism configured to disperse forms of remuneration to a vendor associated with a transaction authorized by said TIPCH (column 6, lines 22-52 and column 8, lines 30-65).

As per claim 4, Katis discloses the financial transaction processing mechanism is a financial institution (column 6, lines 22-52).

As per claim 5, in the system of Katis, a user must log on and provide a password to access the system. Thus, Katis discloses the data terminal further comprises a security mechanism, wherein access to said terminal is restricted to a particular user.

As per claim 6, Katis discloses the transaction and information processing clearing house further comprises a security mechanism, wherein access to said financial and information processing clearing house is restricted to a particular user (column 6, lines 37-44).

As per claim 7, Katis discloses a secure distribution system for distribution of electronic content to a user from said TIPCH, said TIPCH configured to receive

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electronic content from a vendor and to provide the electronic content to a user through said secure distribution system (see figure 3 of Katis).

As per claim 8, Katis discloses the TIPCH is configured to provide electronic content to a user by transmitting the electronic content to a user's transaction device at the request of the user.

As per claim 9, Katis also discloses a distribution channel configured to provide delivery of a product of the transaction. See column 9, lines 5-9.

As per claims 11, 16 and 18, Katis discloses an electronic commerce system, comprising: a data terminal capable of sending and receiving data, said terminal is configured as a financially-enabled e-commerce device to indicate that a transaction is to be performed (figure 1) a transaction and information clearing house (TIPCH) (figure 3, elements 6, 12, and the electronic cash token clearing house);

the TIPCH configured to gather electronic information from a financial institution or vendor for a user having an account within a plurality of separate account within the TIPCH (column 5, lines 9-16);

the TIPCH connected selectively to said data terminal (figure 1); said information automatically transferred to said data terminal when said data terminal is connected to said TIPCH (column 8, lines 43-65) and in response to receipt of the device identifier;

the TIPCH configured to interface with a financial processing system (figure 6); and a financial processing system configured to transfer funds from a user's account to a vendors account when authorized by a data terminal (column 8, lines 43-65);

wherein the data terminal is populated by the TIPCH with sufficient account information about the user account or accounts associated with the device identifier to impart transaction functionality to the terminal on behalf of the user (see column 7, lines 5-19 and column 8, lines 30-56 of Katis).

As per claim 12, in the system of Katis, a user must log on and provide a password to access the system. Thus, Katis, discloses the data terminal further comprises a security mechanism, wherein access to said financial and information processing clearing house is restricted to a particular user.

As per claim 13, Katis discloses the transaction and information processing clearing house further comprises a security mechanism, wherein access to said terminal is restricted to a particular user (column 6, lines 37-44).

As per claim 14, Katis also discloses a distribution system configured to provide delivery of a product of the transaction. See column 9, lines 5-9.

As per claim 17, see column 8, lines 37-51 of Katis.

3. Claims 10 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katis (US Patent No. 6,601,761).

As per claims 10 and 15, the teachings of Katis are discussed above. Katis does not explicitly teach a return system configured to enable the user to return a package to a vendor. Katis discloses a user accessing financial systems online or a via an electronic mail. Furthermore, it is well known in the art that a user has the option of returning a purchased product or package, which the user feels, dissatisfied with. If the

package is an electronic content, the user may return the item online or via mail. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate these features in the system of Katis with the motivation of providing a user with the option of returning an item the user no longer desires or is dissatisfied with.

4. Claims 19-21 and 24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katis (US Patent No. 6,601,761) in view Joao et al (US Patent 6,529,725).

As per claims 19-21, these claims contain features recited in claim 1, and these features are rejected under a similar rationale. As per claims 19-21, Katis teaches registering a transaction device for a user. The terminal of Katis is not stated to be portable transaction device. Joao et al teach a system and method for authorizing a financial transaction at a point of sales or at a remote location. Applicant is directed to the abstract. The system and method comprise means and step of authorizing at least one payment transaction to a financial institution or merchant using a wireless device. Applicant is directed to column 3, line 65 to column 5, line 55. The system and method further comprise steps or means for accepting user input that activates a profile containing pre-stored financial data, pre-stored credit, debit card and check handling information data. See column 7, lines 41-67 and column 11, lines 20-55. The authorization is effected by user input through a wireless device in response to a presentation of a message through the wireless device. See column 7, lines 8-32 and

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column 10, lines 31-67. The wireless device includes a visual presentation device and an audio presentation device. Note column 10, lines 31-67.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Joao et al into Katis in order to allow user's preference of the usage of the system thus providing a flexible and user friendly system.

As per claim 24, the system of Katis is a financially enabled electronic commerce device. See the abstract.

As per claim 25, the electronic-commerce device of Katis is selected from the group of electronic-commerce devices consisting essentially of: cards having a smart card chip, digital wallets, smart cellular phones, home personal computers, web-enabled kiosks and personal digital assistants.

As per claim 26, the clearinghouse of Katis is included within a transaction agent configured to operate on behalf of a registered user.

As-per claim 27, the combination of Katis and Joao et al does not explicitly state the automatic population of the transaction device is being populated comprising a zero click commerce activity. However, Katis and Joao et al disclose providing automatic transfer of electronic information as the transaction is being performed and/or as requested. Thus, no click is necessary. Katis further states making the consumer unaware of which payment vehicle is being used and the financial institution performs payment for the consumer. See column 7, lines 5-19 of Katis.

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5. Claims 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katis (US Patent No. 6,601,761) and Joao et al (US Patent 6,529,725) in view of Sehr (US Patent No. 6, 325,292).

As per claim 22 and 23, the combination of Katis and Joao et al is discussed above. The combination does not explicitly state means for biometric identification within the portable transaction device. Sehr discloses a portable transaction device having stored biometric data for performing a financial transaction. See the abstract. it would have been obvious to one of ordinary skill in the art at the time the invention was made to introduce biometric identification data as taught by Sehr in the combination of Katis and Joao et al in order to provide a more secure system making it difficult for unauthorized users to use.

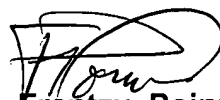
Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantzy Poinvil whose telephone number is (571) 272-6797. The examiner can normally be reached on Monday-Thursday from 7:30AM to 6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sam Sough can be reached at (571) 272-6799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Frantzy Poinvil
Primary Examiner
Art Unit 3628

FP
May 29, 2006



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